

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* GARY W. RAMSDEN and KENNETH WAYNE LILES

Appeal 2007-3141  
Application 10/696,894  
Technology Center 3600

Decided: October 10, 2007

19 Before TERRY J. OWENS, ANTON W. FETTING, and JOSEPH A. FISCHETTI,  
20 *Administrative Patent Judges.*  
21 FETTING, *Administrative Patent Judge.*

## DECISION ON APPEAL

## STATEMENT OF CASE

26 Gary W. Ramsden and Kenneth Wayne Liles (Appellants) seek review under  
27 35 U.S.C. § 134 of a Final rejection of claims 77, 79, and 80, the only claims  
28 pending in the application on appeal.

29 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

30 W. A. FEIDM

1        The Appellants invented an automated unit for preparing an appropriate  
2 mailing label, for validating receipt from a customer of a parcel, package, letter or  
3 other item for shipment, and/or for collecting and holding parcels, packages,  
4 letters, and other items for pick-up by one or more commercial delivery services  
5 (Specification 1:17-23).

6        An understanding of the invention can be derived from a reading of exemplary  
7 claim 77, which is reproduced below [bracketed matter and some paragraphing  
8 added].

9        77. An automated shipping machine for use in mailing a parcel or  
10 envelope comprising:

11        [1] means for receiving payment from a customer;

12        [2] a scale

13                for weighing said parcel or envelope to be mailed and  
14                determining a parcel or envelope weight;

15        [3] a display for displaying

16                at least two selectable delivery options and

17                a cost for said selected delivery option and

18                a cost for a selected delivery option;

19        [4] an input system for receiving information representative of

20                a destination for said parcel or envelope to be mailed and

21                an indication of the delivery option selected by the customer,

22                said delivery option selectable from at least two delivery  
23                options;

24        [5] a processor system in communication with said input system and  
25                said scale for

26                receiving said information representative of

27                the destination,

28                the selected delivery option and

the weight of said parcel or envelope and computing a cost for mailing said parcel or envelope to said destination as a function of said weight and the selected delivery option; inter means in communication with said processor for printing a bar code label for placement on the parcel or envelope to be mailed by the customer identifying at least said destination representative information and to print a shipping receipt for an amount including at least the cost of delivering said parcel or envelope to said destination via the delivery option chosen by said customer.

This appeal arises from the Examiner's Final Rejection, mailed February 3, 2006. The Appellants filed an Appeal Brief in support of the appeal on February 2007. An Examiner's Answer to the Appeal Brief was mailed on March 23, 2007. A Reply Brief was filed on February 12, 2007.

## PRIOR ART

The Examiner relies upon the following prior art:

Tateno US 4,836,352 Jun. 06, 1989  
Hsieh US 4,923,022 May 08, 1990  
Pusic US 5,065,000 Nov. 12, 1991

## REJECTIONS

22 Claims 77 and 80 stand rejected under 35 U.S.C. § 103(a) as unpatentable over  
23 Hsieh and Pusic.

Claim 79 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hsieh, et al., and Tateno.

## ISSUES

Thus, the issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 77 and 80 under 35 U.S.C. § 103(a) as unpatentable over Hsieh and Pusic.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 79 under 35 U.S.C. § 103(a) as unpatentable over Hsieh, Pusic, and Tateno.

The pertinent issue turns on whether Hsieh and Pusic suggest (1) displaying at least two selectable delivery options with costs and (2) computing a cost for mailing a parcel or envelope to a destination as a function of weight and a selected delivery option.

## FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

## *Claim Construction*

01. Claim 77 contains the limitation that a cost for mailing a parcel or envelope to a destination is a function of a weight and a selected delivery option.

1        02. The phrase "function" modifies "cost," not "destination" because the  
2                phrase "to a destination" is itself a modifier of cost and a destination has  
3                no weight.

4        *Hsieh*

5        03. Hsieh is directed toward an automatic mailing apparatus that  
6                automatically weighs, stamps and sorts mail so as to save processing  
7                time in a post office (Hsieh 1:5-8).

8        04. Hsieh's device contains a weighing device, a display screen, and letter  
9                sorting keys (Hsieh 2:36-50).

10        05. After Hsieh weighs a letter or parcel, the weight of the letter will be  
11                shown on the display screen. The customer may then choose the type of  
12                mailing service which sort of mailing type desired by depressing one of  
13                the letter-sorting keys. The postage is then calculated according to the  
14                weight of the letter and the type of mailing service which the operator  
15                selects. The postage will then be shown on the display screen (Hsieh  
16                3:68 – 4:12).

17        *Pusic*

18        06. Pusic is directed toward electronic postage meters having a  
19                microprocessor to control the printing of postage and the accounting  
20                (Pusic 1:5-8).

21        07. Pusic provides an electronically controlled postage meter which  
22                automatically prints the zip code, country code, special request code, and  
23                identification code directly on a postcard, letter, or package in the form  
24                of laser readable bar code. Pusic enables almost all mailings to be

1                   weighed and labeled by an automated electronic means but if this is  
2                   unsuitable, a self-adhesive bar code label can be printed and manually  
3                   stuck on a mailing (Pusic 2:14-25).

4                   08. In Pusic, an inserted mailing is automatically weighed. Its destination  
5                   is entered on a keyboard. A charge is automatically calculated according  
6                   to instructions from the machine's memory. The charge is then  
7                   displayed both to the employee and to the customer and upon a  
8                   confirmation that the charge has been paid, the mailing pressing, bar  
9                   code printing, and mailing dispensing procedures occur. According to  
10                  individual requirements, the bar code printed on a mailing or on a self-  
11                  adhesive label may comprise data about the mailing's destination zip  
12                  code, the country of destination, and any special requests with any other  
13                  identification code which is required for the purpose of tracking a  
14                  mailing with a particular special request (Pusic 2:35-49).

15                  09. Pusic calculates the total postage charge based on the weight of the  
16                  mailing, its destination, any special request data entered on the keyboard,  
17                  and on any data stored in the machine's memory (Pusic 4:60-63).

18                  10. One of ordinary skill in the postal fee setting art would consider a  
19                  delivery option to be a predictable member of the set of special request  
20                  data described by Pusic.

1 PRINCIPLES OF LAW

2 *Claim Construction*

3 During examination of a patent application, pending claims are given  
4 their broadest reasonable construction consistent with the specification. *In*  
5 *re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*  
6 *Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

7 Limitations appearing in the specification but not recited in the claim are not  
8 read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.  
9 Cir. 2003) (claims must be interpreted “in view of the specification” without  
10 importing limitations from the specification into the claims unnecessarily)

11 Although a patent applicant is entitled to be his or her own lexicographer of  
12 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr.*,  
13 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such  
14 definitions in the specification with sufficient clarity to provide a person of  
15 ordinary skill in the art with clear and precise notice of the meaning that is to be  
16 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although  
17 an inventor is free to define the specific terms used to describe the invention, this  
18 must be done with reasonable clarity, deliberateness, and precision; where an  
19 inventor chooses to give terms uncommon meanings, the inventor must set out any  
20 uncommon definition in some manner within the patent disclosure so as to give  
21 one of ordinary skill in the art notice of the change).

22 *Obviousness*

23 A claimed invention is unpatentable if the differences between it and the  
24 prior art are “such that the subject matter as a whole would have been obvious at  
25 the time the invention was made to a person having ordinary skill in the art.” 35

1 U.S.C. § 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1729-30 (2007);  
2 *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

3 In *Graham*, the Court held that that the obviousness analysis is bottomed on  
4 several basic factual inquiries: “[1] the scope and content of the prior art are to be  
5 determined; [(2)] differences between the prior art and the claims at issue are to be  
6 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383  
7 U.S. at 17. *See also KSR Int'l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The  
8 combination of familiar elements according to known methods is likely to be  
9 obvious when it does no more than yield predictable results.” *KSR* at 1739.

10 “When a work is available in one field of endeavor, design incentives and  
11 other market forces can prompt variations of it, either in the same field or in a  
12 different one. If a person of ordinary skill in the art can implement a predictable  
13 variation, § 103 likely bars its patentability.” *Id.* at 1740.

14 “For the same reason, if a technique has been used to improve one device,  
15 and a person of ordinary skill in the art would recognize that it would improve  
16 similar devices in the same way, using the technique is obvious unless its actual  
17 application is beyond his or her skill.” *Id.*

18 “Under the correct analysis, any need or problem known in the field of  
19 endeavor at the time of invention and addressed by the patent can provide a reason  
20 for combining the elements in the manner claimed.” *Id.* at 1742.

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## ANALYSIS

2       *Claims 77 and 80 rejected under 35 U.S.C. § 103(a) as unpatentable over Hsieh  
3 and Pusic.*

4       The Appellants argue these claims as a group.

5       Accordingly, we select claim 77 as representative of the group.

6       37 C.F.R. § 41.37(c)(1)(vii) (2006).

7       The Examiner found that Hsieh described all of the limitations of claim 77  
8 except for the printing limitation [6]. The Examiner found that Pusic described  
9 limitation [6], and that one of ordinary skill would have known that printing  
10 franking codes would provide quicker delivery. The Examiner concluded that it  
11 would have been obvious to a person of ordinary skill in the art to have combined  
12 Hsieh and Pusic to achieve the claimed invention for that reason (Answer 4).

13       The Appellants contend that Hsieh does not compute costs based on the  
14 destination (Appeal Br. 6:Bottom ¶ - 7:Top 2 lines; 7:Second full ¶). The  
15 Appellant also contends that Pusic fails to describe a selectable delivery option  
16 (Appeal Br. 7:First full ¶). The Appellants further argue that Hsieh teaches away  
17 from claim 77 because it is limited to not computations using two variables  
18 (Appeal Br. 8:First full ¶) and there would be no reasonable expectation of success  
19 in achieving the limitations of claim 77 for similar reasons (Appeal Br. 9:Bottom  
20 ¶). The Appellants also contend there is no suggestion to combine Hsieh and Pusic  
21 (Appeal Br. 9:First full ¶). The Appellants conclude that the combination of Hsieh  
22 and Pusic do not allow for different delivery options or are limited to delivery  
23 options whose pricing is independent of destination (Appeal Br. 8:Bottom ¶ -  
24 9:Top 2 lines).

Appeal 2007-3141  
Application 10/696,894

1        The Examiner responded that the cost in claim 77 is only a function of weight  
2 and delivery option (Answer 5:Bottom ¶ - 6).

3        The issue before us is whether the combined teachings of Hsieh and Pusic  
4 suggested different delivery options and a cost to a destination whose pricing may  
5 depend on the delivery option and whether one of ordinary skill would have  
6 combined their teachings.

7        We initially take up the claim construction issue as to whether the cost in claim  
8 77 is a function of destination as well as weight and delivery option. Claim 77  
9 contains the limitation that a cost for mailing a parcel or envelope to a destination  
10 is a function of a weight and a selected delivery option (FF 01). The phrase “to  
11 said destination” modifies cost and is therefore one of the variables. However, the  
12 phrase “function” modifies “cost,” not “destination” because the phrase “to a  
13 destination” is itself a modifier of cost and a destination has no weight (FF 02).  
14 Thus it is not necessary that the invention “calculate the mailing cost of different  
15 destinations for each selected delivery option” as argued (Appeal Br. 7:Second full  
16 ¶).

17        Hsieh describes a postal calculation based on weight and mailing service (FF  
18 05). A mailing service is a delivery option, and therefore Hsieh describes two of  
19 the three variables for postal cost.

20        Pusic describes a postal calculation based on weight and destination, along  
21 with other variables, including special request data (FF 09). One of ordinary skill  
22 in the postal fee setting art would consider a delivery option to be a predictable  
23 member of the set of special request data described by Pusic. Thus, Pusic alone  
24 would suggest computing a postal cost based on weight, destination, and delivery  
25 option.

1        But even if *arguendo* Pusic did not itself suggest delivery option as a variable,  
2 both Pusic and Hsieh clearly convey to one of ordinary skill computing postal costs  
3 based on the variables that affect the cost. Both Pusic and Hsieh describe weight  
4 as one of those variables, and each explicitly recites one of destination and delivery  
5 option. Thus, a person of ordinary skill would have immediately recognized that  
6 all three elements may be parameters in postal cost computations and included all  
7 three in any such computation as a result. “A person of ordinary skill is also a  
8 person of ordinary creativity, not an automaton.” *KSR* at 1742.

9        As to whether one of ordinary skill would have combined Pusic and Hsieh,  
10 both are directed towards postal machines that automatically compute postal costs  
11 (FF 03&06). Pusic describes the advantages of applying its printing technique to  
12 any postal meter such as Hsieh’s (FF 07&08). Thus, Pusic itself provides the  
13 suggestion to combine its teachings with Hsieh.

14       The Appellants also contend that none of the references display at least two  
15 selectable delivery options (Appeal Br. 9:First full ¶).

16       Hsieh displays physical multiple selectable keys for delivery options and also  
17 has a visual computer display (FF 04). One of ordinary skill in the art was  
18 knowledgeable of graphic representations of such keys, along with the information  
19 that selecting each key implied, at the time of the invention. One of ordinary skill  
20 was also aware that relying on such graphic representations could reduce hardware  
21 costs, increase reliability, and make updating their programming more efficient.  
22 Thus, displaying selectable delivery options with costs and the cost for a selected  
23 option would have been no more than a combination of familiar elements that  
24 yielded predictable results and accordingly would have been obvious, *see KSR* at  
25 1739.

1 The Appellants have not sustained their burden of showing that the Examiner  
2 erred in rejecting claims 77 and 80 under 35 U.S.C. § 103(a) as unpatentable over  
3 Hsieh and Pusic.

6 The Appellants argue that claim 79 is patentable for the same reasons as claim  
7 77. The Appellants have not sustained their burden of showing that the Examiner  
8 erred in rejecting claim 79 under 35 U.S.C. § 103(a) as unpatentable over Hsieh,  
9 Pusic, and Tateno.

## CONCLUSIONS OF LAW

11 The Appellants have not sustained their burden of showing that the Examiner  
12 erred in rejecting claims 77, 79, and 80 under 35 U.S.C. § 103(a) as unpatentable  
13 over the prior art.

14 On this record, the Appellants are not entitled to a patent containing claims 77,  
15 79, and 80.

## DECISION

17 To summarize, our decision is as follows:

18 • The rejection of claims 77 and 80 under 35 U.S.C. § 103(a) as unpatentable  
19 over Hsieh and Pusic is affirmed.

20 • The rejection of claim 79 under 35 U.S.C. § 103(a) as unpatentable over  
21 Hsieh, Pusic, and Tateno is affirmed.

22 No time period for taking any subsequent action in connection with this appeal  
23 may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED**

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11 PATENT ADMINISTRATOR  
12 KATTEN MUCHIN ROSENMAN LLP  
13 1025 THOMAS JEFFERSON STREET, N.W.  
14 EAST LOBBY: SUITE 700  
15 WASHINGTON, DC 20007-5201

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